



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Andrey A. BOUKHAROV <i>et al.</i>	Art Unit:	1631
Appln. No.: 09/620,392	Examiner:	Shubo ZHOU
Filed: July 19, 2000	Atty. Docket:	16517.112
For: <i>Plant Genome Sequences and Uses Thereof</i>	Conf. No.:	2901

#28

APPELLANT'S REPLY BRIEF

Commissioner for Patents
Washington, DC 20231

Sir:

This is a reply to a new point of argument not set forth in the Final Rejection, but raised in the Examiner's Answer mailed February 6, 2003 (Paper No. 26) ("Examiner's Answer"). *This Reply Brief is submitted in triplicate.*

1. The Examiner's New Points of Argument

a. The Rejection Raised Under 35 U.S.C. § 112, Second Paragraph

Under Heading Number 6, "Issues", The Examiner's Answer states "in light of appellant's amendment after final rejection and the arguments presented in the brief, . . . the rejections of claims 1 and 2 under 35 U.S.C. 112, second paragraph, are hereby withdrawn." Examiner's Answer at page 2. However, this rejection was *not* raised in the Final Office Action mailed March 1, 2002 (Paper No. 15) ("Final Action") or addressed by Appellant in any paper filed subsequently thereto.

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Although this rejection was raised by the Examiner in the Office Action mailed September 25, 2001 (Paper No. 12), it was withdrawn in the Final Action after Appellant addressed it. *See* Final Action at page 2. In this regard, the arguments and amendments presented by Appellant in the Amendment and Reply Under 37 C.F.R. § 1.111, filed December 21, 2001 (Paper No. 13) (“Amendment and Reply”), presumably overcame this rejection. *See* Amendment and Reply at page 13, line 17 through page 15, line 5. Because the rejection was *not* revisited in the Final Rejection, the statement made in the Examiner’s Answer with respect to 35 U.S.C. § 112, second paragraph, improperly raises a new point of argument.

b. The Statement Regarding the Grouping of Claims

Under Heading Number 7, “Grouping of Claims”, the Examiner’s Answer contains a statement that “[t]he rejections of claims 1-2 stand or fall together because appellant’s brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.” Examiner’s Answer at page 3. *See also* 37 CFR § 1.192(c)(7). While Appellant agrees that claims 1 and 2 stand or fall together for the reasons stated, the statement made in the Examiner’s Answer improperly excludes statements regarding the grouping of claims set forth and independently argued Appellant’s Amended Brief filed November 6, 2002 (Paper No. 25) (“Amended Brief”). As such, this statement improperly raises a new point of argument.

2. Argument

a. The Rejection Raised Under 35 U.S.C. § 112, Second Paragraph

The assertion in the Examiner’s Answer that “. . .the rejections of claims 1 and 2 under 35 U.S.C. 112, second paragraph, are hereby withdrawn” is misleading and confuses the prosecution history of the present application. This statement improperly implies that Appellant took some action after issuance of the Final Action to overcome a rejection under 35 U.S.C. §

112, second paragraph. However, the Final Action contains no such rejection; nor has any rejection under 35 U.S.C. § 112, second paragraph, of any presently pending claim in the application been addressed or argued in either Appellant's Amendment and Reply Under 37 C.F.R. §1.116 filed on June 3, 2002 (Paper No. 16), in Appellant's Brief filed on October 1, 2002 (Paper No. 22), in Appellant's Amended Brief, or in Appellant's Second Amendment After Final Rejection filed September 12, 2002 (Paper No. 23). Appellant wishes only to clarify the record on this point and present a correct assessment of the arguments and amendments presented in the present application after issuance of the Final Action.

b. The Statement Regarding the Grouping of Claims

The Examiner acknowledges that claims 1 and 2 stand or fall together, however this statement presents an incomplete assessment of the currently pending claims, as well as the statement made by Appellant in the Amended Brief. The Final Action rejected claims 1-4, 6-9 and 16-20 under 35 U.S.C. §§ 101 and 112, first paragraph. *See, e.g.*, Amended Brief at page 3, Final Action at pages 3-5. The Final Action separately rejected claims 1-2 and 17-18 under 35 U.S.C. § 102(b). *See, e.g.*, Amended Brief at page 3, Final Action at page 6. Thus, Appellant argued the patentability of claims 1-4, 6-9 and 16-20 together, and the *separate* patentability of claims 1-2 and 17-18 due to the additional rejection of these claims under 35 U.S.C. § 102(b).

Appellant's Amended Brief clearly states this position. In Section 3, "Status of Claims", Appellant stated that "[c]laims 1-4, 6-9 and 16-20 are pending. Claims 1-4, 6-9 and 16-20 stand finally rejected under 35 U.S.C. §§ 101 and 112, first paragraph. Claims 1-2 and 17-18 also stand finally rejected under 35 U.S.C. § 102." Amended Brief at page 2, lines 2-4. Furthermore, in the Amended Brief, under the heading "Grouping of Claims", Appellant stated "Patentability of claims 1-4, 6-9 and 16-20 is addressed together in Sections 8.A through 8.E below. Separate patentability of claims 1-2 and 17-18 is addressed in Section 8.F below." Amended Brief at page 3. Therefore, Appellant did not just argue the rejections stated in the Final Action with respect to

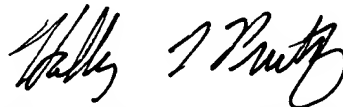
claims 1 and 2 alone, as the statement in the Examiner's Answer would appear to imply. Appellant believes that although this statement may be attributable to a possible error or oversight, it nonetheless improperly represents the grouping of claims presented and argued in the Amended Brief and does not account for the current status of the pending claims.

In light of the Examiner's withdrawal of the rejection of claims 1-2 and 17-18 under 35 U.S.C. § 102(b), *see* Examiner's Answer at page 21, Appellant asserts that claims 1-4, 6-9 and 16-20 are pending and that claims 1-4, 6-9 and 16-20 stand finally rejected under 35 U.S.C. §§ 101 and 112, first paragraph. Therefore, a proper assessment of the grouping of claims would recognize that claims 1-4, 6-9 and 16-20 stand or fall together.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Board of Patent Appeals and Interferences reverse the Rejections and that the subject application be allowed forthwith.

Respectfully submitted,



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